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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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EXAMINER

DELCOTTO, GREGORY R

ART UNIT

PAPER NUMBER

1751

DATE MAILED: 11/22/2002

15

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/704,256

Applicant(s)

HUI SH ET AL.

Examiner

Gregory R. Del Cotto

Art Unit

1751

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on RCE filed 11/4/02.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-21 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-21 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 14.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other:

DETAILED ACTION

1. Claims 1-21 are pending. Applicant's amendments and arguments filed 11/4/02 have been entered.

Continued Examination Under 37 CFR 1.114

A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 11/4/02 has been entered.

Objections/Rejections Withdrawn

2. The following objections/rejections as set forth in Paper #10 have been withdrawn:

The rejection of claims 1-6, 8, and 16-20 under 35 U.S.C. 102(e) as being anticipated by Ospinal et al (US 5,965,508) has been withdrawn.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant

Art Unit: 1751

for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) do not apply to the examination of this application as the application being examined was not (1) filed on or after November 29, 2000, or (2) voluntarily published under 35 U.S.C. 122(b). Therefore, this application is examined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of

Art Unit: 1751

the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

Claims 1-5 and 16-20 are rejected under 35 U.S.C. 102(b) as being anticipated by, or in the alternative, under 35 USC 103 as obvious over Rolfes (US 5,972,861) for the reasons of record set forth in Paper #6.

Claims 1, 4, 5-10, and 13-19 are rejected under 35 USC 103 as being unpatentable over EP 336,740 for the reasons of record set forth in Paper #6.

Claims 1-20 are rejected under 35 USC 103 as being unpatentable over Kaminsky (US 4,487,710) for the reasons of record set forth in Paper #6.

Claims 8 and 15 are rejected under 35 USC 103 as being unpatentable over Rolfes (US 5,972,861) for the reasons of record set forth in Paper #6.

Claim 6 is rejected under 35 USC 103 as being unpatentable over Rolfes (US 5,972,861) as applied to claims 1-5 and 16-20 above, and further in view of Kaminsky (US 4,487,710) or EP 336,740 for the reasons of record set forth in Paper #6.

Claims 1-21 are rejected under 35 U.S.C. 103(a) as being unpatentable over Emery et al (US 6,303,358).

Emery et al teach provide a particulate detergent composition or component having a bulk density of at least 600 g/l and comprising at least 10% by weight of

Art Unit: 1751

detergent surfactant and from 10 to 70% by weight of detergency builder, the detergent composition or component being composed of at least two and preferably at least three, granular components: granules comprising at least 60% by weight of anionic surfactant, granules comprising at least 20% by weight nonionic surfactant and less than 10% by weight aluminosilicate and, optionally, granules comprising up to 100% by weight of detergency builder and optionally from 0 to 10% of nonionic or anionic surfactant. See column 2, lines 5-20. Other detergent ingredients may be postdosed to the composition in order to provide detergent benefits. These ingredients include bleach precursors, alkali metal carbonates, water-soluble crystalline or amorphous alkaline metal silicates, anti-redeposition agents, foam control agents, foam boosters, etc. See column 4, line 55 to column 5, line 5.

Suitable anionic surfactants include fatty ester sulphonates, C8-C15 primary and secondary alkylsulphates, etc. Suitable nonionic surfactants include primary and secondary alcohol ethoxylates, especially the C8-C20 aliphatic alcohols ethoxylated with an average of from 1 to 20 moles of ethylene oxide per mole of alcohol. See column 5, lines 40-60. The particles may be coated with a layering agent. See column 3, lines 10-45.

Emery et al do not specifically teach a granular or powdered detergent composition having reduced di-salt formation containing first particles comprising alpha-sulf fatty acid ester, second particles comprising additional detergent components that cause more than a minor amount of additional di-salt formation, and the other requisite

Art Unit: 1751

components of the composition in the specific proportions as recited by the instant claims.

It would have been obvious to one of ordinary skill in the art, at the time the invention was made, to formulate a granular or powdered detergent composition having reduced di-salt formation containing first particles comprising alpha-sulf fatty acid ester, second particles comprising additional detergent components that cause more than a minor amount of additional di-salt formation, and the other requisite components of the composition in the specific proportions as recited by the instant claims, with a reasonable expectation of success, because the broad teaching of Emery et al suggest a granular or powdered detergent composition having reduced di-salt formation containing first particles comprising alpha-sulf fatty acid ester, second particles comprising additional detergent components that cause more than a minor amount of additional di-salt formation, and the other requisite components of the composition in the specific proportions as recited by the instant claims.

Double Patenting

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Art Unit: 1751

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 1-21 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-27 of copending Application No. 09/574764 (now allowed). Although the conflicting claims are not identical, they are not patentably distinct from each other because claims 1-27 of 09/574764 encompass the material limitations of the instant claims.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

Claims 1-21 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-25 of U.S. Patent No. 6,057,280. Although the conflicting claims are not identical, they are not patentably distinct from each other because claims 1-25 of US 6,057,280 encompass the material limitations of the instant claims.

Response to Arguments

Note that, Applicant has correctly pointed out that a typographical error has been made by the Examiner in rejecting claims 8 to 15 over Rolfes in Paper #10 when it should have been claims 8 and 15. The correction has been made accordingly as set forth above. With respect to Rolfes, EP 336,740, or Kaminsky, Applicant states that Applicant's instant claims generally recite a first or detergent portion and a second portion or alpha-sulfofatty acid ester and that the instant claims contain distinct structural elements that distinguish Applicants' claimed invention from that of Rolfes, EP

Art Unit: 1751

336,740, or Kaminsky. Specifically, Applicant states the claim limitation "in which the particles are commingled, but the particles remain physically distinct" is sufficient to distinguish the instant claims from Rolfes, '740, or Kaminsky in which these references teach agglomeration of particles.

In response, as stated in Paper #10, giving the claims their broadest reasonable interpretation, the Examiner has interpreted a first portion and a second portion which are mixed as recited by claim 1 as simply meaning mixing at least these two components together to form a resultant detergent composition. This interpretation is reinforced by the explanation given on page 4, lines 5-20 of the instant specification, in which it is stated that "each portion typically comprises a plurality of particles... when the particles are admixed, the particles are co-mingled, but remain physically distinct... the portions can be combined in any suitable ratios, according to the desired properties of the final composition." Clearly, Applicants are taking two different components, mixing them to form a final composition in which the portions are mixed but remain physically distinct as in an agglomeration process, and forming a resultant composition. Thus, the Examiner's interpretation of the instant claims appears to be consistent with the explanation given in the specification. The Examiner maintains that the two particles remain physically distinct when agglomerated since the physical properties of each particle does not change; the particles are simply "pushed" together. It is suggested that Applicant include the word "separate" in claim 1 to indicate and clarify that the component first particles and the second particles are not agglomerated together.

Art Unit: 1751

Applicant states that '740 or Kaminsky fail to disclose, teach or suggest that di-salt formation is a problem, that reduced di-salt formation is desired, or any solution to the problem, such as segregating detergent components that cause more than a minor amount of additional di-salt formation from the alpha sulf fatty acid ester.

With respect to the argument that '740 or Kaminsky fail to address or solve the problem of di-salt formation, the Examiner maintains that the reason or motivation to modify the reference may often suggest what the inventor has done, but for a different purpose or to solve a different problem. It is not necessary that the prior art suggest the combination to achieve the same advantage or result discovered by applicant. In re Linter, 458 F.2d 1013, 173 USPQ 560 (CCPA 1972). See MPEP 2144. Note that, '740 or Kaminsky et al teach granular detergent compositions containing the same components in the same proportions as recited by the instant claims and the Examiner maintains that these references would suggest detergent compositions having the same di-salt formation properties as recited by the instant claims.

With respect to the double patenting rejections set forth in Paper #6, Applicant has not submitted any terminal disclaimers and the rejections have been maintained for the reasons of record.

Conclusion

3. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Remaining references cited but not relied upon are considered to be cumulative to or less pertinent than those relied upon or discussed above.

Art Unit: 1751

Applicant is reminded that any evidence to be presented in accordance with 37 CFR 1.131 or 1.132 should be submitted before final rejection in order to be considered timely.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Gregory R. Del Cotto whose telephone number is (703) 308-2519. The examiner can normally be reached on Mon. thru Fri. 8:30 thru 6:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Yogendra Gupta can be reached on (703) 308-4708. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 872-9310 for regular communications and (703) 872-9311 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0661.

GRD
November 19, 2002

GREGORY DELCOTTO
PRIMARY EXAMINER

